

REMARKS

Claims 70-85 are pending, and claims 70-85 stand rejected. Applicant respectfully requests reconsideration of the present application in view of the remarks below.

Information Disclosure Statement

The Examiner states that the Information Disclosure Statement filed on January 30, 2004 fails to comply with 37 C.F.R. § 1.98(a)(1). Accordingly, along with this response, Applicant has filed a new Information Disclosure Statement with the appropriate filing fee.

Double Patenting Rejections

The Examiner rejects claims 70 and 72-85 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 11-19 and 22 of U.S. Patent No. 6,641,596 of Lizardi. The Examiner also rejects claim 71 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of Lizardi in view of U.S. Patent No. 5,814,071 of McDevitt et al., and claim 80 as being unpatentable over the claims of Lizardi in view of U.S. Patent No. 5,928,244 of Tovey et al.

While the Applicant does not agree with the bases for the rejections, in an effort to expedite prosecution of this application to issuance, Applicant submits herewith a Terminal Disclaimer with respect U.S. Patent No. 6,641,596 of Lizardi for the purpose of obviating these rejections. Applicant notes that the primary reference over which the rejection is made, U.S. Patent No. 6,641,596, is the immediate parent of this application -- that is, the present application is a continuation of the application that issued as U.S. Patent No. 6,641,596 ("the parent application"). As such, a single assignment (a copy is included with a Statement Under 37 C.F.R. § 3.73(b) submitted herewith) from the inventor identically assigns to the assignee all right title and interest in both the present application and the parent application.

Claim Rejections Pursuant to 35 U.S.C. § 102

The Examiner rejects claims 70-79 and 81 pursuant to 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,707,395 of Li. The Examiner argues that Li recites all of the elements of Applicant's claims. Applicant respectfully disagrees with the Examiner's rejection.

Claim 70 recites a suture anchor system that includes a bore extending longitudinally from a proximal end, and a suture engaging tip at a distal end. The suture engaging tip has a suture-engaging groove formed therein. When inserted into the tissue, as shown in FIG. 13 reproduced to the right, the distal end having the suture-engaging tip is the leading end. That is, the suture-engaging tip is placed into the tissue first, and the proximal end having the longitudinal bore trails follows. This allows for the suture to be securely held within the tissue.

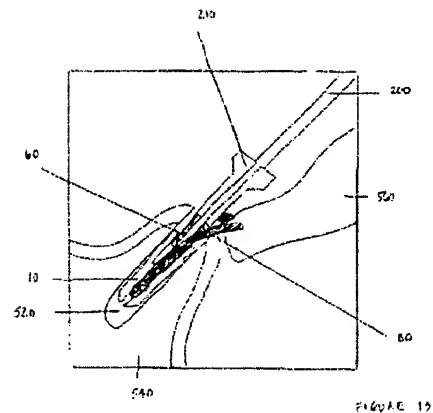


FIGURE 13

Nowhere does Li teach or even suggest the elements of claim 70. Rather, Li teaches a ligament anchor that is configured in the exact opposite way as that of Applicant's. In particular, Li teaches a ligament anchor where the proximal end includes a hole in the side thereof to receive a suture, and the distal end has a bore formed therein. When inserted into bone, as shown in FIG. 2, reproduced to the right, the distal end having the bore is the leading end, and the bore in the distal end receives only an expanding member, not a suture or a ligament. Col. 7, Ins. 13-15. That is, the portion of the anchor having the bore is placed into the bone first, and the proximal end having the hole holding the artificial ligament follows. The placement of the artificial ligament between the joint allows it to have a range of motion similar to that of a natural ligament.

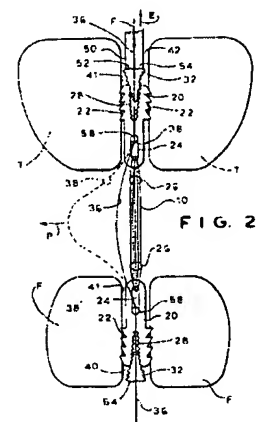


FIG. 2

Applicant further notes that there is no motivation to modify Li's anchor to have the configuration claimed by Applicant because such a modification would render the device inoperable for its intended purpose.

Accordingly, because the disclosure of Li is exactly opposite that of Applicant, claim 70, as well as claims 72-79 and 81 which depend therefrom, distinguish over Li and represent allowable subject matter.

Claim Rejections Pursuant to 35 U.S.C. § 103

The Examiner rejects dependent claim 80 pursuant to 35 U.S.C. § 103(a) as being obvious over Li in view of U.S. Patent No. 5,928,244 of Tovey et al. The Examiner also rejects dependent claims 82-85 are rejected pursuant to 35 U.S.C. § 103(a) as being obvious over Li. As discussed above, independent claim 70 distinguishes over Li. Further, Tovey does not remedy the deficiencies of Li.


Accordingly, dependent claims 80 and 82-85 are therefore allowable because they depend from an allowable base claim.

Conclusion

Applicant submits that all claims are now in condition for allowance, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicant if such communication is deemed to expedite prosecution of this application.

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Respectfully submitted,

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